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10/538,165	06/08/2005	Hiroyuki Hidaka	81887.0124	9232
26/021 7590 04/08/2008 HOGAN & HARTSON LLP. 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067				
EXAMINER				
SANTILAGO CORDERO, MARIVELISSE				
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2617				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/538,165

Applicant(s)

HIDAKA, HIROYUKI

ExaminerMARIVELISSE SANTIAGO-
CORDERO**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 4, 7 and 8 is/are pending in the application.
4a) Of the above claim(s) 1, 2, 5, 6, 9 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 January 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species B (claims 3, 4, 7, 8) in the reply filed on 1/14/2008 is acknowledged.
2. Claims 1-2, 5-6, 9-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/14/2008.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

4. The references cited in the Information Disclosure Statement (IDS) filed on 6/8/2005 and 9/8/2006 have been considered.

Drawings

5. Figures 2, 3A, 3B, 3C, and 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: the term "under" or "with" (page 2, line 14) should be deleted. Appropriate correction is required.

Claim Objections

7. Claims 3-4 and 7-8 are objected to because of the following informalities: the terms "first communication method" and "second communication method" should be replaced with "first communication protocol" and "second communication protocol", respectively, every time it appears in the claims; note that the term "method" implies a means or manner of procedure and/or steps.

Claims 4 and 8 are objected to because the dependency of the claim is incorrect. Claim 4 states "the wireless terminal according to any one of claims 1 to 3"; however, claims 1-2 were withdrawn as being drawn to a nonelected species. The same reasoning applies to claim 8.

In addition, claims 4 and 8 are objected to because the terms "1xEVDO" and "cdma2000 1x" are acronyms, which could mean different things and/or change in meaning overtime, hence it would be desirable to write out the actual words to which the acronym refers.

Claims 7-8 are objected to because the claims are directed to a method which performs wireless communication; however, the claims do not positively set forth the steps involved in the method. It is common US practice for method claims to recite active steps delimiting how the invention is practiced; e.g., a positive and active recitation of steps would be --changing--, --not setting--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 3 and 4 rejected under 35 U.S.C. 102(a) as being anticipated by Applicant's Admitted Prior Art (hereinafter "AAPA").

Regarding claim 3, AAPA discloses a wireless communication terminal (Background Art: page 1, line 25 through page 2, line 7), which performs wireless communication using each of a first communication method and a second communication method (Background Art: page 1, line 25 through page 2, line 7) and enables to be in an idle state with both methods (Background Art: page 2, lines 17-24), comprising:

a setting section that sets a suspend time for detecting an incoming call from a base station using the first communication method subsequent to completion of communication with the base station using the first communication method (Background Art: page 3, lines 4-11; page 12, lines 15-25; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed);

a first changing section that changes a monitoring timing of the second communication method (Background Art: page 2, lines 8-21; page 16, line 20 through page 17, line 3); and

a second changing section that changes a monitoring timing of the first communication method by communicating with the base station when the first changing section changes the

monitoring timing of the second communication method (Background Art: page 2, lines 8-21; page 16, line 20 through page 17, line 3),

wherein the setting section does not set the suspend time (Fig. 3C; page 14, lines 11-12; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed) in a case of communicating with the base station by the second changing section.

In accordance with MPEP 2114, apparatus claims must be structurally distinguishable from the prior art. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “Apparatus claims cover what a device is, not what a device does.” Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

MPEP 2114 further states that the manner of operating the device does not differentiate apparatus claim from the prior art. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)

Regarding claim 4, AAPA discloses wherein the first communication method is a 1xEVDO system, and the second communication method is a cdma2000 1x system (Background Art: page 1, line 25 through page 2, line 7).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter "AAPA") in view of Turner (Pub. No.: US 2003/0152049).

Regarding claim 3, AAPA discloses a wireless communication terminal (Background Art: page 1, line 25 through page 2, line 7), which performs wireless communication using each of a first communication method and a second communication method (Background Art: page 1, line 25 through page 2, line 7) and enables to be in an idle state with both methods (Background Art: page 2, lines 17-24), comprising:

a setting section that sets a suspend time for detecting an incoming call from a base station using the first communication method subsequent to completion of communication with the base station using the first communication method (Background Art: page 3, lines 4-11; page 12, lines 15-25; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed);

a first changing section that changes a monitoring timing of the second communication method (Background Art: page 2, lines 8-21; page 16, line 20 through page 17, line 3); and

a second changing section that changes a monitoring timing of the first communication method by communicating with the base station when the first changing section changes the

monitoring timing of the second communication method (Background Art: page 2, lines 8-21; page 16, line 20 through page 17, line 3),

wherein the setting section does not set the suspend time (Fig. 3C; page 14, lines 11-12; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed).

AAPA fails to specifically disclose in a case of communicating with the base station by the second changing section.

However, in the same field of endeavor, Turner discloses a wireless communication terminal (Fig. 2; Abstract; note the hybrid access terminal), which performs wireless communication using each of a first communication method and a second communication method (Abstract) and enables to be in an idle state with both methods (paragraphs [0057]-[0064]), comprising:

a setting section that sets a suspend time (Fig. 2, reference 214)

wherein the setting section does not set the suspend time in a case of communicating with the base station by the second changing section (paragraphs [0098]-[0101]; note that while the terminal is communicating with the base station (i.e., when data packets are being exchanged) dormancy is not detected and the dormancy timer (i.e., the suspend timer) is not set).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant not to set the suspend time of AAPA in a case of communicating with the base station by the second changing section as suggested by Turner for the advantages of receiving incoming pages at all times when not active (Turner: paragraph [0149]), maintaining

communication resources available, and enabling network operators to develop an accurate picture of true network performance.

Regarding claims 7-8, which recites a method version of claim 3, see rationale as discussed above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vanghi (Pub. No.: US 2002/0111169) discloses a connection management for dual mode access terminals and Jovanovic (Patent No.: US 7,039,410) discloses handoff between 1xEV/3G-1x systems.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIVELISSE SANTIAGO-CORDERO whose telephone number is (571)272-7839. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Trost/
Supervisory Patent Examiner, Art Unit 2617

/MARIVELISSE SANTIAGO-CORDERO/
Examiner, Art Unit 2617